

To: Matthew Powelson(matt@321-law.com)
Subject: U.S. Trademark Application Serial No. 97049906 - MONTEBELLO MARKET - MML.T.001
Sent: May 17, 2023 06:00:39 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 97049906

Mark: MONTEBELLO MARKET

Correspondence Address:

Matthew Powelson
321 LAW, INC.
P.O. BOX 911
MONTEREY CA 93942 UNITED STATES

Applicant: Montebello Market, LLC

Reference/Docket No. MML.T.001

Correspondence Email Address: matt@321-law.com

NONFINAL OFFICE ACTION

Response deadline. File a response to this nonfinal Office action within three months of the “Issue date” below to avoid [abandonment](#) of the application. Review the Office action and respond using one of the links to the appropriate electronic forms in the “How to respond” section below.

Request an extension. For a fee, applicant may [request one three-month extension](#) of the response deadline prior to filing a response. The request must be filed within three months of the “Issue date” below. If the extension request is granted, the USPTO must receive applicant's response to this letter within six months of the “Issue date” to avoid abandonment of the application.

Issue date: May 17, 2023

Introduction

This Office action is in response to Applicant's communication filed on January 23, 2023. Based on information and/or documentation in Applicant's response, the trademark examining attorney now issues this nonfinal Office action to address the following new refusal: amendment to Supplemental

Register unacceptable. *See* TMEP §§706, 711.02.

In a previous Office action dated July 22, 2022, the trademark examining attorney refused registration of the applied-for mark based on the following: Trademark Act Section 2(e)(1) for being merely geographically descriptive.

Applicant's response to the following refusal is insufficient, and the refusal is continued and maintained: Trademark Act Section 2(e)(1) for being merely geographically descriptive.

Applicant must respond to all issues raised in this Office action and the previous July 22, 2022, Office action, within the response deadline mentioned above. 37 C.F.R. §2.62(a); *see* TMEP §711.02. If Applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

Summary of Issues

- NEW ISSUE – Refusal - Amendment to Supplemental Register Unacceptable
- Continued and Maintained – Geographically Descriptive Refusal
- Advisory regarding Amendment to the Supplemental Register After Filing an Amendment to Allege Use to Overcome Refusals

Refusal - Amendment to Supplemental Register Unacceptable

Registration is refused on the Supplemental Register because the proposed mark is not in lawful use in commerce, as required by Trademark Act Section 23. *See* 15 U.S.C. §1091(a); 37 C.F.R. §2.47(a); TMEP §714.05(a)(i). Specifically, this application is based on Applicant's bona fide intention to use the mark in commerce under Section 1(b), and Applicant has not yet submitted an amendment to allege use under 37 C.F.R. §2.76. *See* 37 C.F.R. §§2.47(d), 2.75(b); TMEP §§815.02, 1102.03.

This refusal will be withdrawn if Applicant (1) deletes the amendment to the Supplemental Register, or (2) submits an amendment to allege use that meets the requirements of 37 C.F.R. §2.76(b), (c). *See* TMEP §§815.02, 1102.03.

If Applicant maintains the amendment to the Supplemental Register and provides an acceptable amendment to allege use, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(c) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03. In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Continued and Maintained - Section 2(e)(2) - Geographically Descriptive Refusal

Registration is refused because the applied-for mark is primarily geographically descriptive of the origin of Applicant's services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); *see* TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark to the purchasing public is a generally known

location;

- (2) The goods or services originate in the place identified in the mark; and
- (3) The purchasing public would be likely to believe that the goods or services originate in the geographic place identified in the mark; that is, to make a goods-place or services-place association.

See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc., 2020 USPQ2d 48324, at *5 (TTAB 2020) (citing *In re Nantucket, Inc.*, 677 F.2d 95, 96-97, 213 USPQ 889, 891 (C.C.P.A. 1982)); *see also In re Newbridge Cutlery Co.*, 776 F.3d 854, 860-61, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 (TTAB 2001)); TMEP §1210.01(a).

Applicant has applied to register the mark **MONTEBELLO MARKET** for use in connection with "Retail grocery store services; retail delicatessen services; retail store services for alcoholic and non-alcoholic beverages" in Class 35 and "Restaurant services; take-out restaurant services; cafe services; coffee and tea bars; wine bar and bar services" in Class 43.

First, the primary significance of the term MONTEBELLO in the applied-for mark is a geographic location because the attached evidence from *Ownerly* and *Zillow* establish MONTEBELLO is a street located in Los Gatos, California.

Second, the Applicant's services originate on MONTEBELLO. The attached evidence, consisting of a screenshot from Applicant's website, and the Applicant's listed address in their trademark application reveals MONTEBELLO MARKET is located on Montebello Way in Los Gatos, California.

A goods-place or services-place association may be presumed where (1) the location in the mark is generally known to the purchasing public, (2) the term's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the named location in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) (finding a services-place association was presumed between applicant's restaurant services and California because the services originated in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 850 (TTAB 1982) (finding a goods-place association was presumed between applicant's t-shirts and Denver because the goods had their geographical origin in Denver); *see also In re Nantucket, Inc.*, 677 F.2d 95, 102, 213 USPQ 889, 895 (C.C.P.A. 1982) (Nies, J., concurring) ("[W]e must start with the concept that a geographic name of a place of business is a descriptive term when used on the goods of that business. There is a public goods/place association, in effect, presumed." (internal footnote removed)).

Here because the primary significance of MONTEBELLO is to identify a geographic location and Applicant's services originate on MONTEBELLO, purchasers will presume that the MONTEBELLO identifies the place from which the services originate.

Although the applied-for mark also includes the term MARKET, this does not change the overall primarily geographic significance of the mark.

The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term's primary geographic significance. TMEP §1210.02(c)(ii); *see,*

e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc., 2020 USPQ2d 48324, at *6-7 (TTAB 2020) (holding CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a well-known harbor in Charleston, South Carolina); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (holding HOLLYWOOD LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory).

In this case, the term MARKET immediately conveys that Applicant's services relate to retail store and restaurant services because evidence from *the American Heritage Dictionary* establishes the wording MARKET refers to "a public gathering held for buying and selling goods or services". Additional evidence from *The Capistrano Dispatch* and the *Washingtonian* demonstrate the wording MARKET is commonly used in connection with similar services to describe a characteristic, feature, or purpose of one's retail and restaurant services. Given that Applicant is selling their retail and restaurant goods and services in a public gathering, the wording is descriptive of Applicant's services. Thus, the wording MARKET does not diminish the overall geographic significance of the applied-for mark.

Ultimately, when purchasers encounter the applied-for mark in the marketplace, they will immediately understand the mark as identifying the geographic origin of Applicant's services, and not an indication that Applicant is the source of the services. Therefore, the mark is primarily geographically descriptive of the origin of Applicant's services, and registration is refused pursuant to Section 2(e)(2) of the Trademark Act.

Advisory regarding Amendment to the Supplemental Register After Filing an Amendment to Allege Use to Overcome Refusals

Although an amendment to the Supplemental Register would be an appropriate response to this refusal in an application based on Trademark Act Section 1(a) or 44, such a response is not appropriate in the present case. The instant application was filed under Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If Applicant files an acceptable allegation of use and also amends to the Supplemental Register, the application effective filing date will be the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for an amendment to allege use. TMEP §§816.02, 1102.03; *see* 37 C.F.R. §2.75(b). In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages to the registrant:

- (1) Use of the registration symbol ® with the registered mark in connection with the designated goods and/or services, which provides public notice of the registration and potentially deters third parties from using confusingly similar marks.
- (2) Inclusion of the registered mark in the USPTO's database of registered and pending marks, which will (a) make it easier for third parties to find it in trademark search reports, (b) provide public notice of the registration, and thus (c) potentially deter third parties from using confusingly similar marks.

- (3) Use of the registration by a USPTO trademark examining attorney as a bar to registering confusingly similar marks in applications filed by third parties.
- (4) Use of the registration as a basis to bring suit for trademark infringement in federal court, which, although costlier than state court, means judges with more trademark experience, often faster adjudications, and the opportunity to seek an injunction, actual damages, and attorneys' fees and costs.
- (5) Use of the registration as a filing basis for a trademark application for registration in certain foreign countries, in accordance with international treaties.

See 15 U.S.C. §§1052(d), 1091, 1094; J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§19:33, 19:37 (rev. 4th ed. Supp. 2017).

Response guidelines. For this application to proceed, Applicant must explicitly address each refusal and requirement in this Office action. For a refusal, Applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, Applicant should set forth the changes or statements. Please see “[Responding to Office Actions](#)” and the informational [video “Response to Office Action”](#) for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal and requirement in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. File a [response form to this nonfinal Office action](#) or file a [request form for an extension of time to file a response](#).

/Sloan Taylor/
Sloan Taylor
Examining Attorney
LO129--LAW OFFICE 129
(571) 272-7130
Sloan.Taylor@uspto.gov

RESPONSE GUIDANCE

- **Missing the deadline for responding to this letter will cause the application to [abandon](#).** A response or extension request must be received by the USPTO before 11:59 p.m. **Eastern Time**

of the last day of the response deadline. Trademark Electronic Application System (TEAS) [system availability](#) could affect an applicant's ability to timely respond. For help resolving technical issues with TEAS, email TEAS@uspto.gov.

- [Responses signed by an unauthorized party](#) are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find** [contact information for the supervisor](#) of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on May 17, 2023 for
U.S. Trademark Application Serial No. 97049906

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response, or extension request, must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Otherwise, your application will be [abandoned](#). See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and whether there are outstanding deadlines to the [Trademark Assistance Center \(TAC\)](#).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your serial number in our database, [TSDR](#), to confirm that it appears under the “Documents” tab, or contact the [Trademark Assistance Center](#).
- **[Hiring a U.S.-licensed attorney](#)**. If you do not have an attorney and are not required to

have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.